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| 10/814,428 | 04/01/2004 | Luc Gourlaouen | 05725.1315-00 | 5713 |
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| FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413 | | | | |
| EXAMINER | | | | |
| FRAZIER, BARBARA S | | | | |
| ART UNIT | | PAPER NUMBER | | |
| 1611 | | | | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/814,428

Applicant(s)

GOURLAOUEN ET AL.

Examiner

BARBARA FRAZIER

Art Unit

1611

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 June 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 6-13, 22, 23, 30, 66 and 69 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 6-13, 22, 23, 30, 66 and 69 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SF/08)
Paper No(s)/Mail Date 6/5/09
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Status of Claims

1. Claims 6-13, 22, 23, 30, 66, and 69 are pending in this application. Cancellation of claims 1-5, 14-21, 24-29, 31-65, 67, and 68 is acknowledged.
2. Claims 6-13, 22, 23, 30, 66, and 69 are examined.

Allowable Subject Matter

3. The previously noted allowable subject matter, wherein the at least one fluorescent dye is of the formula (F3) and the at least one aminosilicone is of the formula (A), is withdrawn in view of the new grounds of rejection hereinbelow.

Claim Rejections - 35 USC § 102

4. The rejection of claims 1, 3, 4, 6, 9-13, 22, 23, 66, 68, and 69 under 35 U.S.C. 102(b) as being anticipated by Matsunaga et al in view of *Handbook* is withdrawn in view of Applicant's amendments to claims 6 and 66, and Applicant's cancellation of claims 1, 3, 4, and 68.

Claim Rejections - 35 USC § 103

5. The rejection of claims 1, 5, 9-13, and 30 under 35 U.S.C. 103(a) as being unpatentable over Luo et al is withdrawn in view of Applicant's cancellation of claims 1 and 5, and amendments to claims 9, 12, and 30.

6. The rejection of claim 2 under 35 U.S.C. 103(a) as being unpatentable over Matsunaga et al in view of Peters et al is withdrawn in view of Applicant's cancellation of claim 2.
7. The rejection of claims 5 and 67 under 35 U.S.C. 103(a) as being unpatentable over Matsunaga et al as evidenced by *Handbook* and further in view of Kalopissis et al is withdrawn in view of Applicant's cancellation of claims 5 and 67.

Double Patenting

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. **Claims 6-13, 22, 23, 30, 66, and 69 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-29 and 44-45 of U.S. Patent No. 7,195,651 in view of *International***

***Cosmetic Ingredient Dictionary and Handbook* ("Handbook"), Seventh Edition (1997), page 73** (previously cited); **claims 1-34 and 45-47 of U.S. Patent No.**

7,250,064 in view of *Handbook*; **claims 50-97 of U.S. Patent No. 7,303,589** in view of *Handbook*; **or claims 1-36 of U.S. Patent No. 7,150,764** in view of *Handbook*.

The instant application is drawn to a cosmetic composition comprising, in a cosmetically acceptable medium, at least one fluorescent dye that is soluble in the medium, of the formula (F3), and at least one aminosilicone, according to claim 6.

Patents 7,195,651, 7,250,064, 7,303,589, and 7,150,764 each claim a composition comprising, in a cosmetically acceptable medium, a fluorescent dye of formula (F1) or (F3). One skilled in the art would reasonably be able to choose the (F3) compounds from a list of just two groups of compounds by routine experimentation.

Patents 7,195,651, 7,250,064, 7,303,589, and 7,150,764 do not teach the presence of the aminosilicone in the composition.

Handbook teaches that the aminosilicone of formula (A) is a known cosmetic ingredient, commonly used in hair dyes (see page 73). The aminosilicone is a known hair conditioning agent (see page 73).

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to add the aminosilicone of formula (A) to the fluorescent dye compositions of patents 7,195,651, 7,250,064, 7,303,589, and 7,150,764 ; thus arriving at the claimed invention. One skilled in the art would have been motivated to do so because the addition of the aminosilicone would provide the dye compositions with the benefit of conditioning the hair, as taught by *Handbook*. One would reasonably expect

success from the addition of the aminosilicone to the dye compositions of patents 7,195,651, 7,250,064, 7,303,589, and 7,150,764 because *Handbook* expressly teaches that the aminosilicone is known to be used in hair dyes.

Regarding dependent claims 7-13, 22, 23, and 30, said limitations are claimed in the dependent claims of patents 7,195,651, 7,250,064, 7,303,589, and 7,150,764.

Regarding claims 66 and 69, Patent 7,195,651 claims a multi-compartment device comprising the dye composition in one compartment and an oxidizing agent in another compartment (see claim 44). This multi-compartment kit is also claimed in claim 45 of 7,250,064 and claim 97 of patent 7,303,589.

Conclusion

No claims are allowed at this time.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to BARBARA FRAZIER whose telephone number is (571)270-3496. The examiner can normally be reached on Monday-Thursday 9am-4pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sharmila Landau can be reached on (571)272-0614. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

BSF

/Sharmila Gollamudi Landau/
Supervisory Patent Examiner, Art Unit 1611